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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,239	04/18/2001	Christof Gysler	88265-4024	1362

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WINSTON & STRAWN
PATENT DEPARTMENT
1400 L STREET, N.W.
WASHINGTON, DC 20005-3502

EXAMINER	
LAMBERTSON, DAVID A	

ART UNIT	PAPER NUMBER
1636	

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/837,239	GYSLER ET AL.	
	Examiner	Art Unit	
	David A. Lambertson	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-8,13,14 and 19-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-8,13 and 20-23* is/are rejected.

7)☒ Claim(s) *14 and 19* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of a reply to the previous Office Action, filed February 26, 2004. Amendments were made to the claims. Specifically, claims 1-5, 9-12 and 15-18 were cancelled, and claims 19-23 were added.

Claims 6-8, 13, 14 and 19-23 are pending and under consideration in the instant application. Any rejection of record in the previous Office Action, mailed August 26, 2003, that is not addressed in this action has been withdrawn.

Because this Office Action only maintains rejections set forth in the previous Office Action and/or sets forth new rejections that are necessitated by amendment, this Office Action is made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **This is a new rejection that is necessitated by amendment to the claims.**

The term "desired" in claim 6 is a relative term which renders the claim indefinite. The term "desired" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Specifically, it is not clear whether the lti-property is the

"desired" property, or if some other property is "desired." In the latter case, it is unclear who determines the desirability of the property; if the determination is subjective, the term "desirability" will have different criteria depending on the individual making the determination. Without a definition of what is a "desirable" trait, claims 6 and 20-23 are indefinite as failing to define the limitations of the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 6-8, 13, 20, 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gysler (as recited in the previous Office Action). **This rejection is maintained for the reasons**

set forth in the previous Office Action, and is now applied to newly added claims 20, 21 and 23.

Claims 6-8, 13, 20, 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Takano (as recited in the previous Office Action). **This rejection is maintained for the reasons set forth in the previous Office Action, and is now applied to newly added claims 20, 21 and 23.**

Response to Arguments Concerning Claim Rejections - 35 USC § 102

Applicant's arguments filed February 6, 2004 have been fully considered but they are not persuasive. The following grounds of traversal are provided:

1. With regard to both the Gysler and Takano references, Applicant asserts that neither reference specifically teaches "a modified industrial baker's yeast having a low temperature inactive (lti)-property characterized by having a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C" (see Applicant's arguments, page 5, penultimate paragraph).

2. It is asserted that the Gysler reference does not teach a yeast that is derived from a sporulated tetraploid zygote yeast without using a mutagen (see Applicant's arguments, page 5, penultimate paragraph).

3. It is asserted that the Gysler reference does not teach the specific strains NCIMB 41002, 41032 or 41033 (see Applicant's arguments, page 5, last paragraph).

Applicant's arguments have been fully considered, but are not convincing for the following reasons:

1. It is noted that the only structural limitation placed on the claimed yeast strain is that it displays an "lti-property." Thus, absent evidence to the contrary, it can only be presumed that a yeast strain displaying an lti-property will necessarily have a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C, absent some evidence to the contrary that said strain does not have such a property.

Both Takano and Gysler teach yeast strains displaying an lti-property, and thus meet the only structural limitation of the claimed product. Applicant has provided no reason why the strains taught by Takano and/or Gysler do not have a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C, instead simply stating that neither reference teaches such a strain. However, both references teach yeast strains having an lti-property; this begs the question: what structural feature of the instantly claimed yeast strain is not present in the yeast strains of Takano and Gysler, such that the instantly claimed yeast strain has a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C, yet the Takano and Gysler yeast strains do not. For example, it is unknown if there is a specific genetic mutation (i.e., a structural feature) that confers the ability to have a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C, wherein said mutation is present in the instantly claimed strains but not in the Takano and Gysler strains. If there is such a structural feature, it is not recited in the claims to distinguish the instant strains from those of Takano and Gysler, which otherwise meet the structural limitations of (and thus anticipate) said strain.

Because both Gysler and Takano teach the only structural limitation of the claimed invention, and Applicant has not provided an argument or evidence as to why this structural limitation is not sufficient to anticipate the instantly claimed invention, the rejection is maintained in view of the traversal.

2. It is reiterated that the instant claims are a "product-by-process" claims, meaning that the claimed invention is the final product, and not the method of obtaining said product. Thus, unless the process for obtaining the product confers upon the product some structural or functional feature, the process carries no patentable weight. In other words, if the same product can be obtained by another method, than the addition of method steps as a limitation does not distinguish the claimed product from the product as obtained by the alternative method.

In the instant case, the claims are directed to a yeast strain having an lti-property, whereby the strain has a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C. If such a strain can be obtained by a method that does not involve the sporulation of a tetraploid yeast strain, than that strain can anticipate the claimed strain in the absence of the specifically recited method steps for obtaining the claimed strain. As set forth in the previous Office Action, and in response to Applicant's arguments above, the only structural feature of the strain is that it displays an lti-property. There is nothing to distinguish one lti-property from another in either the specification or the instant claims, thus it can only be presumed that any strain having an lti-property necessarily has a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C. Because the strains taught by Takano and Gysler both display an lti-property, the strains meet the structural

and functional limitations of the claimed yeast strain, even in the absence of the method steps to obtain the claimed yeast strain.

3. It is noted that there is no assertion that either Takano or Gysler anticipates the specific strains NCIMB 41002, 41032 or 4103. Because the claims containing this limitation are not rejected, the argument is moot.

In conclusion, it is asserted that Takano and Gysler anticipate the instantly rejected claims because each teaches a yeast strain having an lti-property. Absent a structural feature that necessarily results in a strain that has a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C, wherein said property is not the result of an lti-property, the strains taught by Takano and Gysler necessarily have a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C by virtue of their having an lit-property. The method steps to obtain said strain do not carry patentable weight because they do not appear to confer upon the yeast strains a functional feature that cannot be obtained by constructing the strains through another method. In other words, Gysler and Takano each teach distinct methods of obtaining a yeast strain with an lti-property, which necessarily has a CO_2 production of less than about 1 ml/g dough per hour at refrigeration temperatures from about 3°C to 12°C. Therefore, Applicant's arguments are not convincing and the rejection is maintained.

Allowable Subject Matter

Claims 14 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (571) 272-0771. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David A. Lambertson, Ph.D.
AU 1636

JAMES KETTER
PRIMARY EXAMINER